

### V. REMARKS

Claims 1-4 are rejected under 35 USC 103 (a) as being unpatentable over Weiss (U.S. Patent No. 6,623,006) in view of Loose (EP 1260928). The rejection is respectfully traversed.

Weiss teaches a gaming machine that includes a video game display and a housing. The video game display has substantially planar front and rear surfaces and a periphery extending between the surfaces including one peripheral side adjacent another game display. The one side has a wall spaced from the other game display by a minimum clearance and immediately adjacent the other game display. The housing has an openable front panel and two changeable game displays oriented in side by side relationship. The two displays are exposed through the front panel and are visually accessible by a player. The video game display is a liquid crystal display.

Loose discloses a reel-spinning slot machine with superimposed video images. The reel-spinning slot machine includes a plurality of mechanical rotatable reels and a video display. The reels are rotated and stopped to randomly place symbols on the reels in visual association with a display area. The video display provides a video image superimposed upon the reels. The video image may be interactive with the reels and includes graphics such as payout values, a pay table and the like.

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) quoting In re Rinehart, 531

F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1776). The mere fact that the prior art *may* be modified in the manner suggested by the Examiner neither makes the modification *prima facie* obvious or obvious unless the prior art suggested the desirability of the modification. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the references to arrive at the claimed invention. If the Examiner fails to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.

It is respectfully submitted that the Examiner fails to consider all of the claimed features of the invention, especially those that are missing from the prior art.

Claim 1 is directed to a gaming machine that includes a variable display device for variably displaying designs and a front display device disposed in front of the variable display device. Claim 1 recites that the front display device includes an electrical display device for allowing the variable display device to be observed therethrough and a rear holder for holding the electrical display device from a rear side thereof. Claim 1 further recites that the rear holder has one or more windows allowing the designs variably displayed in the variable display device to be observed and that the peripheral corner portions in the rear side of the windows are removed therefrom.

Claim 4 is directed to a gaming machine that includes a variable display device for variably displaying designs and a front display device disposed in front of the variable display device. Claim 4 recites that the front display device includes an electrical display device for allowing the variable display device to be observed therethrough and a rear holder for holding the electrical display device from a rear side thereof. Claim 4 further recites that the rear holder has a front face and a rear

face defining a thickness therebetween and has one or more windows for allowing the designs variably displayed in the variable display device to be observed. Additionally, claim 4 recites that each window has a first recessed portion formed into the front face and a second recessed portion formed into the rear face and being larger than the first recessed portion. Further, claim 4 recites that an interface of the first and second recessed portions defines a stepped-down rear holder surface disposed between the front face and the rear face such that the stepped-down rear holder surface surrounds the first recessed portion.

It is respectfully submitted that none of the applied art, alone or in combination, teaches or suggests the features of claims 1 and 4. Specifically, it is respectfully submitted that the applied art, alone or in combination, fails to teach or suggest the rear holder and its features as recited in claim's 1 and 4. In fact, on Page 3 of the Office Action, it states, "The Examiner does agree that the references do not teach or suggest a rear holder that the peripheral corner portions in the rear side of the windows are removed." Thus, it is respectfully submitted that one of ordinary skill in the art could not combine the features of the applied art to arrive at the claimed invention because the applied art is devoid of all the features of the claimed invention.

Clearly, the Examiner impermissibly fails to consider all of the claimed features of the invention, especially those that are missing from the prior art, namely the claimed rear holder and its claimed features.

On Page 3 of the Office Action, it states, "... however, in light of the applicant's disclosure, it seems that this limitation as claimed does not provide any advantage used for a particular purpose or solves a problem. Therefore, the Examiner holds this limitation as a mere design choice well within the skill set of an ordinary skilled artisan."

Under 35 U.S.C. §103(a), a patent may not be obtained though the invention is not identically disclosed or described . . . if the differences between the subject

matter sought to be patented and the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art. . . It is respectfully submitted that the results and advantages are a part of the claimed invention as a whole. It is a basic tenet of patent law that the U.S. Patent and Trademark Office is not permitted to ignore the results and advantages produced by claimed subject matter, of which the prior art is devoid, simply because the claimed limitations are similar to that otherwise barren prior art. Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 7 USPQ2d 1315 (Fed. Cir. 1988); In re Chupp, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987); Formson v. Advance Offset Plate, 755 F.2d 1549, 225 USPQ 26 (Fed. Cir. 1985).

It is respectfully submitted that the Applicant has set forth throughout the application the results and the advantages of the claimed invention. For instance, as recited in the specification:

On Page 3:

[0007] According to this configuration, the electrical display device disposed in front of the variable display means for variably displaying designs serves as a new machine component for performing game effects. Further, *since the peripheral corner portions in the rear side of the windows formed in the rear holder are removed therefrom, the peripheral corner portions are prevented from being viewed by the player when a player observes the variable display means behind the electrical display device.*

On Page 27:

[0048] Furthermore, in the slot machine 1 in accordance with this embodiment, the peripheral corner portions in the rear face side of the openings 5c, 6c and 7c formed in the rear holder 39h are removed therefrom. Accordingly, when a player observes the reels 2-4 behind the liquid crystal panel 39d through the transparent acryl plate 39a, as demonstrated with an arrow in FIG. 3(b), the peripheral corner

portions are prevented from being viewed by the player. Owing to this, the player recognizes the thickness of the rear holder 39h as thinner, and as a result, the thickness of the reel display window unit 39 is entirely prevented from being recognized.

[0049] As described above, according to this invention, the electrical display device disposed in front of the variable display means for variably displaying designs serves as a new machine component for performing game effects. Further, since peripheral corner portions in the rear side of the windows formed in the rear holder are removed therefrom, the peripheral corner portions are prevented from being viewed by the player when a player observes the variable display means behind the electrical display device. Accordingly, new game effects can be performed on the electrical display device panel, which facilitates maintaining the novelty of game effects. Moreover, since the peripheral corner portions in the rear face side of the windows formed in the rear holder are not visible, the player recognizes the thickness of the rear holder as thinner, and as a result, the thickness of the electrical display device is entirely prevented from being recognized.

It is respectfully submitted that the U.S. Patent and Trademark Office impermissibly ignored the results and advantages produced by claimed subject matter, of which the prior art is devoid.

In view of the above, it is respectfully submitted that claims 1 and 4 are allowable over the applied art.

Claims 2 and 3 depend from claim 1 and include all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

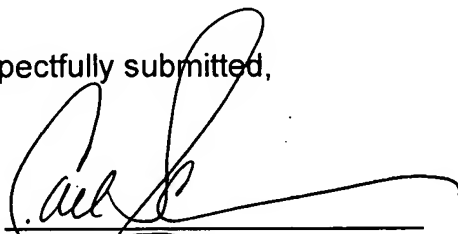
Withdrawal of the rejection is respectfully requested.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything

further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

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Enclosure(s):       Amendment Transmittal

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